

Appl. No. : 09/652,730  
Filed : August 31, 2000

### **REMARKS**

The following remarks are responsive to the January 29, 2003 Final Office Action. Claims 1-19 and 21-30 remain as originally filed and are presented for further consideration in view of the following remarks.

#### **Comments Regarding Telephonic Interview**

Applicants thank the Examiner for extending the courtesy of a telephonic interview to Applicants' representative, Bruce S. Itchkawitz, on April 29, 2003. During the telephonic interview, Claim 1 of the present application was discussed in light of the disclosure of U.S. Patent No. 6,002,394 to Schein et al. ("Schein"). While agreement was not reached regarding allowability of the claims, the Examiner stated that he would consider Applicants' arguments once submitted in writing. The remarks in this Response are in accordance with the discussion of the telephonic interview, and Applicants respectfully request that the Examiner reconsider the pending rejections in view thereof.

#### **Response to Rejection of Claims 1-12, 19, and 22-30 Under 35 U.S.C. § 102(e)**

In the January 29, 2003 Final Office Action, the Examiner rejects Claims 1-12, 19, and 22-30 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,002,394 to Schein et al. ("Schein"). Applicants respectfully submit that Claims 1-12, 19, and 22-30 include limitations not disclosed by Schein. For the reasons presented below, Applicants respectfully request the Examiner to withdraw the rejection of Claims 1-12, 19, and 22-30 and to pass these claims to allowance.

##### **Claim 1**

Applicants respectfully submit that Schein does not disclose a "digital video recorder connectable to a set-top box ... the digital video recorder comprising: at least one recorder interface connectable to the auxiliary interface; a storage device; a microprocessor configured to control the digital video recorder and the set-top box, the microprocessor comprising an electronic program guide subsystem connected to the recorder interface to receive the electronic program guide information from the set-top box and to process the electronic program guide information to schedule recording the broadcast audiovisual data on the storage device; and a video output interface separate from the recorder interface, the video output interface connectable to a display device" as defined by Claim 1.

Claim 1 defines a digital video recorder that (i) is connectable to a set-top box (STB); and (ii) comprises a microprocessor. The Examiner asserts that Schein discloses such a microprocessor as processor 16 of Figure 1. However, the processor of Schein does not satisfy all the limitations of the microprocessor of Claim 1, as described below.

The digital video recorder and the STB of Claim 1 are separate components, since Claim 1 defines that the “digital video recorder [is] connectable to a set-top box.” Claim 1 further defines that “the digital video recorder compris[es] ... a microprocessor.” In contrast, the processor of Schein is disclosed to be contained in the computer 12 of Figure 1 which can be located within a STB. Thus, the processor of Schein does not satisfy the limitation of Claim 1 in which the microprocessor is in the digital video recorder. By citing the whole system of Schein (as illustrated by Figure 1 of Schein) as the “digital video recorder,” the Examiner has not considered that Claim 1 discloses a digital video recorder separate but connectable to a STB.

In addition, Claim 1 defines that the digital video recorder comprises a recorder interface and that the microprocessor is “connected to the recorder interface to receive the electronic program guide information from the set-top box.” The Examiner identifies the connection of the VCR 36 to the TV 32 as inherently having a recorder interface as defined by Claim 1. However, the processor of Schein is not connected to this interface between the VCR and the TV to receive electronic program guide information from the STB. Thus, the processor of Schein does not satisfy the limitation of Claim 1 in which the microprocessor is connected to the recorder interface to receive the electronic program guide information from the STB.

Schein also does not disclose a digital video recorder comprising a video output interface separate from the recorder interface connectable to a display device as defined in Claim 1. As shown by Schein in Figure 1, the connection between the VCR and the TV implies an interface within the digital video recorder as identified by the Examiner. However, Schein does not disclose a video output interface separate from this connection between the VCR and the TV, whereby this separate interface is connectable to a display device. Thus, Schein does not satisfy the limitation of Claim 1 in which the digital video recorder has a video output interface separate from the recorder interface and connectable to a display device.

As explained in MPEP § 2131, a claim is anticipated only if “each and every element as set forth in the claim is found in a single prior art reference” (emphasis added). Furthermore, the

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elements in the reference “must be arranged as required by the claim” (emphasis added). See, e.g., In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). The Examiner has pointed out that Schein discloses a system which includes a set-top box, a recorder interface, a storage device, a microprocessor, and a video output interface. However, as discussed above, the elements in the system of Schein are not arranged as required by Claim 1 of the present application. Therefore, Claim 1 is not anticipated by Schein.

For the foregoing reasons, Claim 1 defines features that are not disclosed by Schein and Applicants respectfully submit that Claim 1 is patentably distinguished over Schein. Applicants respectfully request the Examiner to withdraw the rejection of Claim 1 and to pass Claim 1 to allowance.

#### Claims 2-12

Claims 2, 4-6, and 10-11 each depend from Claim 1, Claim 3 depends from Claim 2, Claims 7-9 each depend from Claim 6, and Claim 12 depends from Claim 11. Each of Claims 2-12 includes all the limitations of Claim 1, and further recites limitations of particular utility in addition to the limitations of Claim 1. Therefore, Claims 2-12 are each patentably distinguished over Schein since each claim includes limitations which are not disclosed by Schein. Applicants respectfully request the Examiner to withdraw the rejections of Claims 2-12 and to pass these claims to allowance.

#### Claim 19

Applicants respectfully submit that Schein does not disclose the invention defined in Claim 19. In particular, Schein does not disclose a “digital video recorder connectable to a set-top box ... the digital video recorder comprising: at least one device interface connectable to the auxiliary interface; a microprocessor configured to control the digital video recorder and the set-top box, the microprocessor comprising an electronic program guide subsystem connected to the device interface to receive and process the electronic program guide information from the set-top box; and a video output interface separate from the device interface, the video output interface connectable to a display device.”

As described above with respect to Claim 1, Schein does not disclose the limitation of Claim 19 in which the microprocessor in the digital video recorder. In addition, Schein does not disclose the limitation of Claim 19 in which the microprocessor is connected to the device

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interface to receive the electronic program guide information from the set-top box. Furthermore, Schein does not disclose the limitation of Claim 19 in which the digital video recorder has a video output interface separate from the device interface and connectable to a display device.

For the foregoing reasons, Claim 19 defines features that are not disclosed by Schein and Applicants respectfully submit that Claim 19 is patentably distinguished over Schein. Applicants respectfully request the Examiner to withdraw the rejection of Claim 19 and to pass Claim 19 to allowance.

#### Claim 22

Applicants respectfully submit that Schein does not disclose the invention defined in Claim 22. In particular, Schein does not disclose a method for communicating electronic program guide (EPG) information from a STB to a digital video recorder comprising a video output interface and a microprocessor comprising an EPG subsystem, the method comprising "connecting at least one recorder interface of the digital video recorder to at least one auxiliary interface of the set-top box, the recorder separate from the video output interface and connected to the electronic program guide subsystem; recognizing the connection of the digital video recorder to the set-top box; and communicating the electronic program guide information from the set-top box to the electronic program guide subsystem."

As described above, Schein does not disclose the limitation of Claim 22 in which the digital video recorder is connected to the STB via a recorder interface separate from the video output interface. In addition, Schein does not disclose the limitation of Claim 22 in which the connection between the digital video recorder and the STB is recognized. Furthermore, Schein does not disclose the limitation of Claim 22 in which EPG information is communicated from the STB to the EPG subsystem of the microprocessor in the digital video recorder.

For the foregoing reasons, Claim 22 defines features that are not disclosed by Schein and Applicants respectfully submit that Claim 22 is patentably distinguished over Schein. Applicants respectfully request the Examiner to withdraw the rejection of Claim 22 and to pass Claim 22 to allowance.

#### Claims 23-30

Claims 23, 26, 27, and 30 each depend from Claim 22. Claims 24-25 each depend from Claim 23, and Claims 28-29 each depend from Claim 27. Each of Claims 23-30 includes all the

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limitations of Claim 22, and further recites limitations of particular utility in addition to the limitations of Claim 22. Therefore, Claims 23-30 are each patentably distinguished over Schein since each claim includes limitations which are not disclosed by Schein. Applicants respectfully request the Examiner to withdraw the rejections of Claims 23-30 and to pass these claims to allowance.

**Response to Rejection of Claims 13, 14, 16, and 17 Under 35 U.S.C. § 103(a)**

In the January 29, 2003 Final Office Action, the Examiner rejects Claims 13, 14, 16, and 17 under 35 U.S.C. § 103(a) as being unpatentable over Schein in view of U.S. Patent No. 6,003,041 to Wugofski ("Wugofski"). The Examiner asserts that Schein teaches essentially the claimed invention except for wherein the auxiliary interface or the recorder interface supports isochronous communication or asynchronous communication. The Examiner further asserts that Wugofski teaches these limitations by virtue of using an IEEE-1394 interface and that it would have been obvious to modify Schein by using such an interface.

As described above, Schein does not disclose all the limitations of Claim 1. Furthermore, Wugofski does not teach, disclose, or suggest the limitations of Claim 1 not disclosed by Schein. Therefore, Applicants respectfully submit that Claim 1 is patentably distinguished over Schein in view of Wugofski.

Claims 13, 14, 16, and 17 each depend from Claim 1. Each of Claims 13, 14, 16, and 17 includes all the limitations of Claim 1, and further recites limitations of particular utility in addition to the limitations of Claim 1. Therefore, Claims 13, 14, 16, and 17 are each patentably distinguished over Schein in view of Wugofski. Applicants respectfully request the Examiner to withdraw the rejections of Claims 13, 14, 16, and 17 and to pass these claims to allowance.

**Response to Rejection of Claims 15 and 18 Under 35 U.S.C. § 103(a)**

In the January 29, 2003 Final Office Action, the Examiner rejects Claims 15 and 18 under 35 U.S.C. § 103(a) as being unpatentable over Schein in view of U.S. Patent No. 5,963,264 to Jackson ("Jackson"). The Examiner asserts that Schein teaches essentially the claimed invention except for wherein the auxiliary interface or recorder interface supports synchronous communication. The Examiner further asserts that Jackson teaches these limitations and that it would have been obvious to modify Schein to support synchronous communication.

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As described above, Schein does not disclose all the limitations of Claim 1. Furthermore, Jackson does not teach, disclose, or suggest the limitations of Claim 1 not disclosed by Schein. Therefore, Applicants respectfully submit that Claim 1 is patentably distinguished over Schein in view of Jackson.

Claims 15 and 18 each depends from Claim 1 and includes all the limitations of Claim 1. Claims 15 and 18 each further recites additional limitations of particular utility. Therefore, Claims 15 and 18 are each patentably distinguished over Schein in view of Jackson. Applicants respectfully request the Examiner to withdraw the rejection of Claims 15 and 18 and to pass these claims to allowance.

**Response to Rejection of Claim 21 Under 35 U.S.C. § 103(a)**

In the January 29, 2003 Final Office Action, the Examiner rejects Claim 21 under 35 U.S.C. § 103(a) as being unpatentable over Schein in view of U.S. Patent No. 5,699,107 to Lawler et al. ("Lawler"). The Examiner asserts that Schein teaches essentially the claimed invention except for wherein the digital video recorder comprises a user viewing monitor that keeps track of and compiles a user viewing history and set of user preferences. The Examiner further asserts that Lawler teaches these limitations and that it would have been obvious to modify Schein to provide these limitations.

As described above, Schein does not disclose all the limitations of Claim 19. Furthermore, Lawler does not teach, disclose, or suggest the limitations of Claim 19 not disclosed by Schein. Therefore, Applicants respectfully submit that Claim 19 is patentably distinguished over Schein in view of Lawler.

Claim 21 depends from Claim 19 and includes all the limitations of Claim 19. Claim 21 further recites additional limitations of particular utility. Therefore, Claim 21 is patentably distinguished over Schein in view of Lawler. Applicants respectfully request the Examiner to withdraw the rejection of Claim 21 and to pass this claim to allowance.

**Summary**

In view of the foregoing remarks, Applicants respectfully submit that Claims 1-19 and 21-30 are in condition for allowance, and such action is respectfully requested.

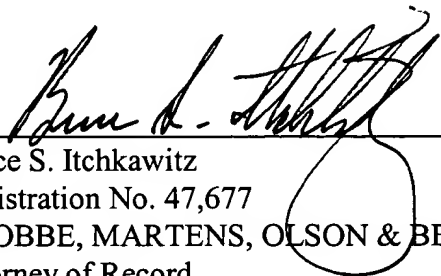
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Respectfully submitted,

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